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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,186	04/07/2004	Thomas R. Marsh	9066-23DV	7421

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EXAMINER	
LUGO, CARLOS	

ART UNIT	PAPER NUMBER
3676	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/820,186	MARSH ET AL.	
	Examiner	Art Unit	
	Carlos Lugo	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-11,13 and 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-11,13 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *attachments 1 and 2*.

DETAILED ACTION

1. This Office Action is in response to applicant's request for reconsideration filed on October 27, 2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 5 is rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,858,583 to McEvoy et al (McEvoy).

McEvoy discloses a device comprising a base member (27 and 28) having opposite first and second faces and a cushioning projection (25) extending outwardly from the second face of the base member and covering and defining a void within the base member. The projection has a planar portion opposite the convex portion. The planar portion of the base member across the void has a thickness less than the thickness of the base member.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1,4,6-11,13, and 14 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 3,952,455 to McAlarney (McAlarney '455).

Regarding claims 1,13 and 14, McAlarney '455 discloses an article comprising first and second confronting components (1 and 2), wherein one of the components is a frame (1) and the other one is a movable member (2) connected to the frame and movable from an open and a closed position.

The article further comprises a device comprising a base member (20) having opposite first and second faces and a cushioning projection extending outwardly from the second face of the base member and covering and defining a void (26-29) within the base member. The base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. A clip (21,23 and 25) is connected to the base member. The clip has a first member (21) connected to the base member, a second member (23) connected to the first member, and a cavity formed by the base member and the first and second members of the clip. The device is formed as a unitary member and is entirely formed of a polymeric material (Col. 3 Lines 42-62).

As to the fact that the article claimed is an article of furniture, McAlarney '455 discloses that while the device is discussed to be use on a refrigerator, it may be employed for various purposes where it has a door and a frame so as to give cushion when the door is closed (Col. 1 Lines 8-22). Therefore, the device described by McAlarney '455 is capable of being used in an article of furniture so as to provide cushioning to the door when the door is closed.

As to claim 4, McAlarney '455 illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

As to claim 6, McAlarney '455 illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, McAlarney '455 illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, McAlarney '455 illustrates that the cushioning projection is generally semi-circular.

As to claim 9, McAlarney '455 illustrates that the cushioning projection has an opening at one end (Figure 1).

As to claim 10, McAlarney '455 illustrates that the cushioning projection is closed at both ends (Figures 2-4).

McAlarney '455 fails to positively disclose that the cushioning projection has a thickness of between about .020 and about .090 inches. McAlarney '455 illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by McAlarney '455 with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates

any showing of criticality having this dimension as the thickness of the cushioning portion.

6. **Claims 1,4, and 6-11 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman in view of US Pat No 1,998,791 to Schanz.

Regarding claim 1, Tinnerman discloses an article of furniture (Col. 1 Lines 1-7) comprising first and second confronting components (A and B), wherein one of the components is a frame (A) and the other one is a movable member (B) connected to the frame and movable from an open and a closed position.

The article further comprises a device (C) comprising a base member having opposite first and second faces and a cushioning projection (Figures 1 and 2) extending outwardly from the second face of the base member and covering and defining a void within the base member. The device is formed as a unitary member and entirely form of a polymeric material.

However, Tinnerman fails to disclose that the device further comprises a clip connected to the base member. Tinnerman discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material. Schanz further teach that the clip (15) has a first member (15) connected to a base member and a second member (16 and 16') and a cavity formed between the first and second members and the base member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by Tinnerman with a clip, as taught by Schanz, in order to attach and secure the device to a surface with a simple and easy to install structure.

As to claim 4, Tinnerman illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void (when the convex portion is compressed).

As to claim 6, Tinnerman illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, Tinnerman illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, Tinnerman illustrates that the cushioning projection is generally semi-circular.

As to claim 9, Tinnerman illustrates that the cushioning projection has an opening at one end (Figure 1).

As to claim 10, Tinnerman illustrates that the cushioning projection is closed at both ends.

As to claim 11, Tinnerman illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by

Tinnerman with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

7. **Claim 5 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 3,952,455 to McAlarney (McAlarney '455) in view of US Pat No 2,858,583 to McEvoy et al (McEvoy).

McAlarney '455 discloses a device comprising a base member (20) having opposite first and second faces and a cushioning projection extending outwardly from the second face of the base member and covering and defining a void (26-29) within the base member. The projection has a planar portion opposite the convex portion.

However, McAlarney '455 fails to disclose that the planar portion of the base member across the void has a thickness less than the thickness of the base member.

McEvoy teaches that it is well known in the art to provide a cushioning projection (25) extending outwardly from a base member and covering and defining a void within the base member, with a planar portion of the base member across the void, opposite the convex portion, that has a thickness less than the thickness of the base member. McEvoy teaches that it could have the same thickness (Figure 2), more thickness (Figure 2a) or less thickness (Figure 2b).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the planar portion across the void of McAlarney '455 device with less thickness than the base member, as taught by

McEvoy, in order to aid in the cushioning of the door when is closed with respect to a doorframe.

8. **Claims 13 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman in view of US Pat No 1,998,791 to Schanz and further in view of US Pat No 6,148,584 to Wilson.

Tinnerman discloses a device (C) comprising a base member having opposite first and second faces and a cushioning projection (Figures 1 and 2) extending outwardly from the second face of the base member and covering and defining a void within the base member. The device is formed as a unitary member and entirely form of a polymeric material.

However, Tinnerman fails to disclose that the device further comprises a clip connected to the base member. Tinnerman discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material. Schanz further teach that the clip (15) has a first member (15) connected to a base member and a second member (16 and 16') and a cavity formed between the first and second members and the base member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by Tinnerman with a clip, as

taught by Schanz, in order to attach the device to a surface with a simple and easy to install structure.

Further, Tinnerman fails to disclose that the base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. Tinnerman only discloses that the base member has a planar portion extending away from the cushioning projection on one side of the protrusion.

Wilson teaches that it is well known in the art to have a planar portion extending away from the cushioning projection on opposite sides of the projection (Figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning portion described by Tinnerman with two planar portions at opposing sides of the projection, as taught by Wilson, since, first, the duplication of components of a prior art device is a design consideration within the skill of the art, and second, in order to provide support for the cushioning portion. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having these planar portions at opposite sides of the projection.

Response to Arguments

9. Applicant's arguments filed on October 27, 2006 have been fully considered but they are not persuasive.

The drawing objection has been withdrawn in view of the explanation given by the applicant, in which the opening referring to in claim 9 is an opening at either side of the cushioning device (for example, Figure 2, where 124 is pointing, and not that the cushioning device is open at one end (see attachment #1).

Since this point was clarified, the rejection in view of Widman has been withdrawn. However, both McAlarney '455 and Tinnerman disclose the limitation.

The applicant argues that McAlarney '455 fails to disclose a frame and a movable member connected to the frame (Page 7 Line 1). McAlarney '455 clearly discloses a frame (1) having a movable member (2) connected to the frame. Therefore, the rejection is maintained.

The applicant further argues that neither Tinnerman nor Schanz discloses a first member connected to the base member and a second member connected to the first member, as cited in claim 1 (Page 7 Line 12). The applicant further argues that the prior art fails to show a structure as shown in Figure 5.

As seen in attachment #2, Schanz clearly illustrates this limitation. The applicant needs to clearly claim the invention illustrated in figure 5 so as to overcome this rejection. Therefore, the rejection is maintained.

The applicant argues that McEvoy fails to disclose that the base member comprises a planar portion across the void that has a thickness that is less than the thickness of the base member (Page 9 Line 10).

The claim language does not require that is planar from one end to the other so as to maintain the same thickness. At the instant, McEvoy discloses the invention as claimed. Therefore, the rejection is maintained.

As to the applicant's arguments with respect to claim 13 (Page 10), see arguments above.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

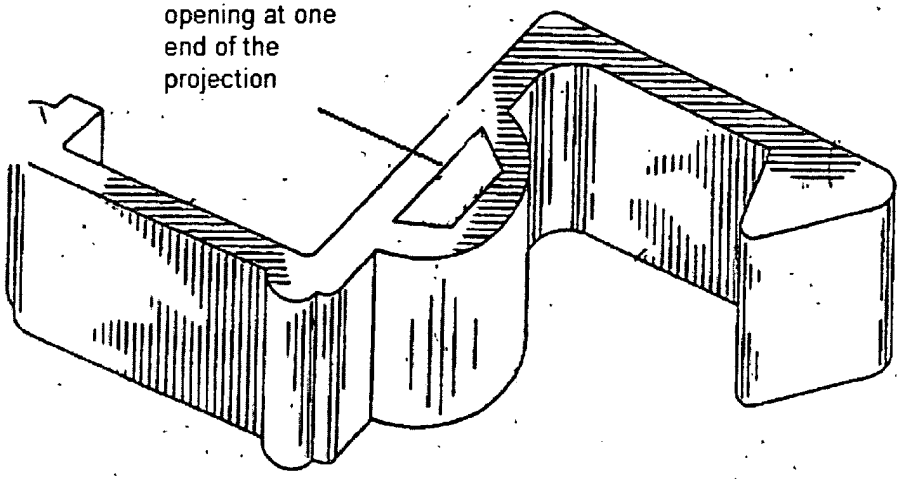
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 571-272-7058. The examiner can normally be reached on 10-7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Carlos Lugo
Patent Examiner
Art Unit 3676

May 1, 2007.



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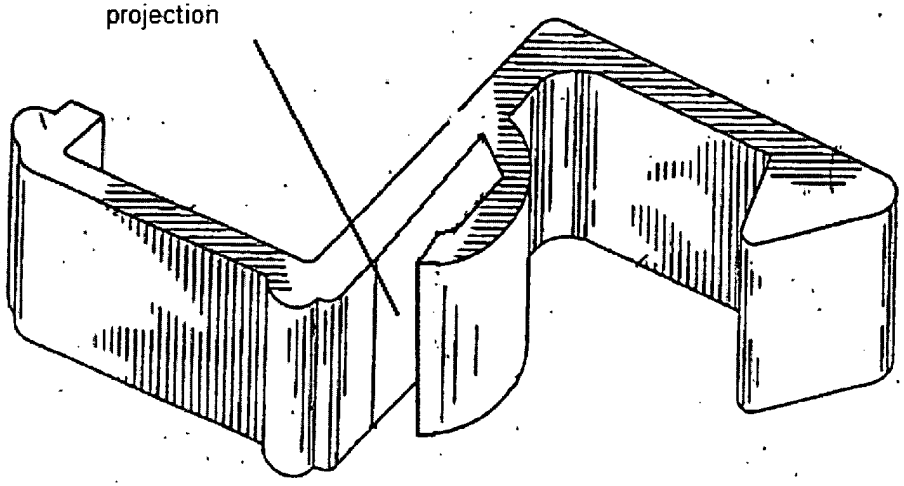

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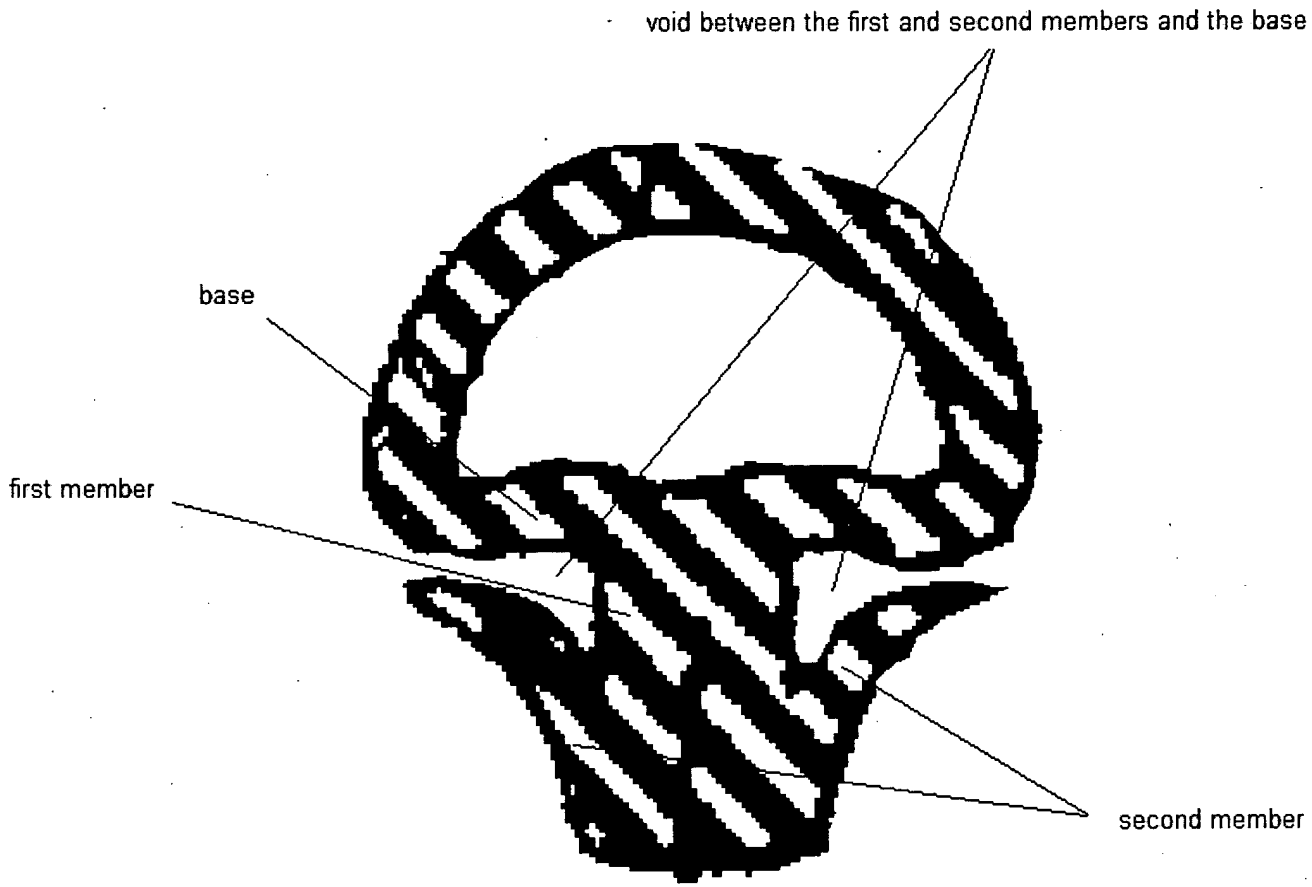
interpretation

attachment #1



Attachment #2